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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,255	11/08/2000	Brett T. Hannigan	P0243	3458

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DIGIMARC CORPORATION
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EXAMINER

RADA, ALEX P

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,255

Applicant(s)

HANNIGAN ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,11-14 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-2, 4-6, and 20-22 is/are allowed.
- 6) ☒ Claim(s) 8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

In response to the amendment filed November 30, 2005 in which the applicant cancels claims 3, 7, 9-10, and 15-19, amends claims 1 and 20, adds new claims 23-24, and claims 1-2, 4-6, 8, 11-14, and 21-24 are pending in this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (5,89,700) in view of Rifkin et al. (US 6,065,969).

3. Williams et al disclose decoding machine-readable information conveyed with a printed publication and performing an action based on the information (summary).

Williams et al does not expressly disclose the action is retrieving artwork from a data store and printing the artwork for coloring by a child.

Rifkin et al teaches the retrieving artwork from a data store, in which the examiner interprets the CD-ROM to be equivalent to the data store and printing the artwork for coloring by a child, in which the examiner interprets the game of customizing the nail coverings and then printing the designs to be an equivalent to printing the artwork for coloring by a child. By retrieving artwork

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from a data store and coloring and printing of the design, one of ordinary skill in the art would provide a virtually endless amusing activity for fashion and entertainment.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Williams et al to include retrieving artwork from a data store and printing the artwork for coloring by a child as taught by Rifkin et al to provide a virtually endless amusing activity for fashion and entertainment.

4. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (US 5,640,193) in view of La Tour (US 5,888,070) and Linebarger (US 6,068,485).

5. Wellner discloses the following:

Decoding machine-readable information conveyed with a printed publication and performing an action based on the information as recited in claim 11.

Wellner does not expressly disclose the following:

The associated action is speech and the speech incorporates both text from the book and substitute words as recited in claim 11.

Retrieving the substitute words from a local store as recited in claim 12.

Soliciting words from a child, recording the child's words, and using the recorded word as the substitute words as recited in claim 13.

The substitute words customize the book text to a particular child or locale as recited in claim 14.

La Tour teaches the following:

The associated action is speech and the speech incorporates both text from the printed publication and substitute words, in which the examiner interprets the

recording of parts of the text (word) to be equivalent and capable of incorporating text from the book and substitute words (summary) as recited in claim 11.

Soliciting words from a child, recording the child's words, and using the recorded word as the substitute words, in which the examiner interprets the recording of parts of the text (word) being equivalent and capable of incorporating text from the book and substitute words (summary) as recited in claim 13.

The substitute words customize the book text to a particular child or locale, in which the examiner interprets the multipart drama to be an equivalent to the customizing of the textbook (summary) as recited in claim 14.

Linebarger teaches the following:

Retrieving the substitute words from a local store, in which the examiner interprets the memory (12) to be an equivalent to the words from a local store as recited in claim 12. By incorporating substituted, recorded, and stored local words, one of ordinary skill in the art would provide a learning aid to enhance a child's interest in reading.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Rhoads to further include the action of the associated action is speech and the speech incorporates both text from the book and substitute words, retrieving the substitute words from a local store, soliciting words from a child, recording the child's words, and using the recorded word as the substitute words, and the substitute words customize the book text to a particular child or locale as taught by La Tour and Linebarger to enhance a child's interest in reading.

Allowable Subject Matter

6. Claims 1-2, 4-6, and 20-22 are allowed for the reasons set forth in the previous office action mailed July 27, 2005 and claims 23-24 are allowed for the same reasons.

Response to Arguments

7. Applicant's arguments filed November 30, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APR


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TC3700